

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on October 2, 2002, the Examiner indicated that the rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by Wadsworth et al. (U.S. Patent No. 6,214,351 B1, hereinafter "Wadsworth") was withdrawn and that the rejection of claims 1-18, 20 and 22-27 under 35 U.S.C. 103(a) as being unpatentable over Lane (U.S. Patent No. 5,503,825, hereinafter "Lane") was also withdrawn. In the Office Action, the Examiner rejected claims 1, 6-8, 11-12, 22 and 27 under 35 U.S.C. 103(a) as being unpatentable over Krog et al. (U.S. Patent No. 5,945,092, hereinafter "Krog") in combination with Wadsworth, rejected claims 1 and 6 under 35 U.S.C. 103(a) as being unpatentable over Wadsworth or in view of Moniz (U.S. Patent No. 5,288,491, hereinafter "Moniz"), and rejected claims 1, 6-8, 11-12, 22 and 27 under 35 U.S.C. 103(a) as being unpatentable over Pillai et al. (U.S. Patent No. 6,261,566, hereinafter "Pillai") in view of Wadsworth and in further view of Moniz.

Rejections under 35 U.S.C. § 103

An invention is unpatentable under 35 U.S.C. §103(a) "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains." In order to establish a *prima facie* case of obviousness, three criteria must be met, namely: "First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2142.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be “found in the prior art, and not based on applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Indeed, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” MPEP § 2142. Furthermore, a “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under 35 U.S.C. 103. *Id.*

For at least the reasons set forth below, Applicants submit that the prior art fails to teach or suggest all of the claim limitations, and fails to clearly and particularly suggest the combination indicated by the Examiner. Accordingly, the claim set as provided herein is not obvious in view of the prior art references cited by the Examiner.

Applicants have amended independent claim 1 to recite a lip treatment comprising a composition for topical application to provide lip care, wherein the composition includes *Morinda citrifolia* seed oil present in an amount between about 0.1-20 percent by weight; *Morinda citrifolia* fruit juice present in an amount between about 0.1-50 percent by weight; and at least one of: (i) linoleic acid; and (ii) xeronine. The inclusion of both *Morinda citrifolia* seed oil and *Morinda citrifolia* fruit juice adds no new matter as it finds adequate support in the specification as filed. (see page 13 of the application as filed) In contrast, the references cited by the Examiner do not anticipate, teach, or render obvious the inclusion of both *Morinda citrifolia* seed oil and *Morinda citrifolia* fruit juice. Furthermore, the cited references do not

anticipate, teach, or render obvious the inclusion of *Morinda citrifolia* fruit juice in a composition for topical application.

Krog discloses an anhydrous cosmetic stick composition comprising, among other components, 1-20% of a cosmetically acceptable essential oil. Krog fails to mention or suggest *Morinda citrifolia* fruit juice as a possible beneficial component of the disclosed invention.

Wadsworth teaches a process of extracting and purifying *Morinda citrifolia* oil from the seeds of the *Morinda citrifolia* plant. Wadsworth also fails to disclose or suggest use of *Morinda citrifolia* fruit juice for any purpose.

Moniz discloses a method for processing a *Morinda citrifolia* plant into powder. While Moniz discloses that *Morinda citrifolia* fruit juice may be ingested by a patient to treat certain systemic disorders, Moniz neither discloses nor suggests topical application of a *Morinda citrifolia* fruit juice-containing compound, as disclosed by the present application. Instead, Moniz teaches away from a topical application of a *Morinda citrifolia* fruit juice-containing compound as Moniz emphasizes that the benefits of noni juice may only be realized upon activation of the “appreciable amounts of the precursor of xeronine” present in the juice. Moniz notes that the best chance of noni juice becoming activated is if the juice is taken on an empty stomach. (Col. 3, lines 12-17) Accordingly, Moniz discourages one skilled in the art from topically applying *Morinda citrifolia* fruit juice.

Pillai is directed to cosmetic skin care compositions for topical application. Pillai specifically teaches cosmetic use of “a glycolic extract from the root of white mulberry,” otherwise known as *Morus Alba*. (Col. 2, lines 27-29) Pillai neither discloses nor suggests use or substitution of *Morinda citrifolia* fruit juice, or a derivative thereof, for or in addition to the mulberry extract.

There are a variety of substantial differences in the properties between the *Morus alba* and the *Morinda citrifolia*. For example, the *Morus alba* and the *Morinda citrifolia* are classified in separate and distinct plant families. The *Morus alba* belongs to the *Moraceae* family of plants, while the *Morinda citrifolia* belongs to the *Rubiaceae* family of plants. Characteristics common to the *Moraceae* family include leaves that are simple, alternate, and rarely opposite, and flowers that are unisexual and minute. In contrast, the *Rubiaceae* family features leaves that are simple and usually entire, and are opposite or whorled. Furthermore, *Rubiaceae* flowers are typically bisexual.

Based on the divergent classifications and characteristics of the *Morus alba* and *Morinda citrifolia* plants, one skilled in the art would not consider such plants interchangeable or likely to induce similar effects. In addition, Pillai relies on the combined effect of *Morus alba* specifically and selected retinoids. Accordingly, Pillai is limited to a composition that specifically includes *Morus alba*. Since Pillai fails to suggest, and in fact teaches away from, the use or substitution of *Morinda citrifolia*, or any derivative thereof, for or in addition to the *Morus alba*, the present claim set is not anticipated, taught, or rendered obvious by Pillai.


Applicants respectfully submit that the inability of the combined references cited by the Examiner to produce the invention as claimed, and the lack of any suggestion or motivation to modify such art to produce Applicants' invention as claimed renders the present invention non-obvious in view of such references. Accordingly, the prior art references cited by the examiner do not anticipate, teach, or render obvious the claims of the present invention as provided herein.

CONCLUSION

Applicants respectfully submit that the claim set provided herein does not add new matter and is now in condition for allowance. Accordingly, Applicants therefore request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,



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VERSION WITH MARKINGS SHOWING CHANGES MADE

1. A lip treatment comprising:

a composition for topical application to provide lip care, wherein the composition includes:

Morinda citrifolia seed oil present in an amount between about 0.1-20 percent by weight;

Morinda citrifolia fruit juice present in an amount between about 0.1-50 percent by weight; and

at least one of:

- (i) linoleic acid; and
- (ii) xeronine.

Claims 2 – 5 were cancelled previously.

6. (Cancel)

7. The lip treatment of claim 1, further comprising at least one of:

- (i) dimethicone present in an amount between about 1-5 percent by weight;
- (ii) octyl salicylate present in an amount between about 1-5 percent by weight;
- (iii) oxybenzone present in an amount between about 1-5 percent by weight;
- (iv) cetyl alcohol present in an amount between about 1-5 percent by weight;
- (v) squalane present in an amount between about 1-5 percent by weight;

- (vi) butylated hydroxytoluene present in an amount between about 1-5 percent by weight;
- (vii) beeswax present in an amount between about 1-5 percent by weight;
- (viii) phenyl trimethicone present in an amount between about 1-5 percent by weight;
- (ix) benzophenone-3 present in an amount between about 1-5 percent by weight;
- (x) sorbitan oleate present in an amount between about 1-5 percent by weight;
- (xi) a wax derivative present in an amount between about 1-5 percent by weight;
- (xii) isopropyl lanolate present in an amount between about 1-5 percent by weight; and
- (xiii) isocetyl stearate present in an amount between about 1-5 percent by weight[;].

8. The lip treatment of claim 1, further comprising at least one of:

- (i) octyl methoxycinnamate present in an amount between about 5-10 percent by weight;
- (ii) lanolin present in an amount between about 5-10 percent by weight;
- (iii) paraffin present in an amount between about 5-10 percent by weight; and
- (iv) isopropyl myristate present in an amount between about 5-10 percent by weight.

Claims 9 – 10 were cancelled previously.

11. The lip treatment of claim 1, further comprising petrolatum present in an amount between about 20-80 percent by weight.

12. The lip treatment of claim 1, further comprising ozokerite present in an amount between about 5-20 percent by weight.

Claims 13 – 21 were cancelled previously.

22. The lip treatment of claim 1, further comprising white petrolatum present in an amount between about 40-70 percent by weight.

Claims 23 – 26 were cancelled previously.

27. The lip treatment of claim 1, further comprising ingredients selected from the group consisting of Menthol, Myristyl Lactate, Myristyl Myristate, Octyl Palmitate, Vitamin E, Avocado Oil, Cetyl Alcohol, Chamomile Oil, Isopropyl Lanolate, Microcrystalline Wax, Propylparaben, Shea Butter, Zinc Oxide, Aloe Vera Extract, Methylparaben, Jojoba Oil and, Fragrance, Cetyl Alcohol, Aloe Extract, Methylparaben, Propylparaben, Vitamin E Acetate, Vitamin E Linoleate, Sodium Saccharinate, Sweet Almond Oil, Macadamia Ternifolia (Nut) Seed Oil, Kukui Nut Oil, Shea Butter, Camphor Gum, Menthol, Tocopheryl Acetate (Vitamin E

Acetate), Propylparaben, and Flavor, each present in an amount between about 0-1 percent by weight.

Please cancel claims 28 - 30.

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